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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re William O'Neill Foundation

Serial No. 75742677

Stephanie Furgang Adwar¹ of Furgang & Adwar, L.L.P. for the William O'Neill Foundation.

Alicia P. Collins, Trademark Examining Attorney, Law Office 115 (Tomas Vlcek, Managing Attorney).

Before Simms, Rogers and Drost, Administrative Trademark Judges.

Opinion by Drost, Administrative Trademark Judge:

On July 2, 1999, the William O'Neill Foundation² (applicant) applied to register the mark EQOP, in typed form, on the Principal Register for goods and services originally identified as:

¹ Applicant's current attorney was not the attorney who filed the brief in this case.

² Applicant has identified itself as the William O'Neill Foundation in its application. In other papers filed simultaneously with the application, it is identified as the William W. O'Neill Foundation.

Entertainment services and production services of all types, towels, paper and toiletry products, chronometers, CD-ROMs, light fixtures of all types, sunglasses, sports equipment and accessories, animation, stationery products, jewelry of all types, stuffed toys and toys, advertising services of all types, umbrellas, wall and floor coverings of all types, and the like in International Class 42.³

The examining attorney⁴ has refused to register applicant's mark until applicant clarifies the identification of its goods and services and pays the fee for any additional classes of goods and services. 15 U.S.C. §§ 1051(b)(2) and 1112 and 37 CFR § 2.86(a)(2).

In the first Office action, the examining attorney advised applicant that the identification of the goods and services was indefinite and that the goods and services were classified in more than one class. Applicant responded that its "Statement of Goods is appropriate." Response dated April 3, 2000. After the examining attorney made the requirement for a clarification of the identification of the goods and services final, applicant filed a notice of appeal.

³ Serial No. 75742677. The application is based on an allegation of a bona fide intention to use the mark in commerce. This application was, for a time, apparently consolidated with Serial No. 75742425. However, Office records indicate that the '425 application is still in the examining operation.

⁴ The current examining attorney was not the original examining attorney in this case.

On October 15, 2001, applicant filed an appeal brief and an amendment to the identification of goods and services.

Applicant's entire appeal brief is set out below:

In Paper No. 1, the Examining Attorney requests that the Applicant amend the Statement of Goods to use the common commercial names for the goods. However, "when a mark is used on a number of items which make up a homogenous group, a term which identifies the group as a whole would be understood as encompassing products of the same general type which are commercially related." TMEP 804.03. "ENTERTAINMENT SERVICES and PRODUCTION SERVICES" are understood as identifying a particular group of goods. Furthermore, "toiletry products" identifies a particular group of goods. In fact, the Examining Attorney admits this in Paper No. 2.

Accordingly, Applicant's Recitation is appropriate. Therefore, Applicant respectfully requests that the Examining Attorney's refusal be reversed.

Applicant's proposed amended identification of goods and services, submitted simultaneously with its appeal brief, including possible International Classes, is also set out:

Computer and multimedia software, namely CD-ROMs and Diskettes [International Class 9];

Jewelry, namely earrings, necklaces, pendants, bracelets, watches, and the like [International Class 14];

Stationery products, namely letterhead, envelopes, business cards, brochures, posters, bulletins, stickers, and brochures [International Class 16];

Sports equipment and accessories, namely, baseballs, golf balls, golf tees, golf club covers, footballs, Frisbees [sic], basketballs, towels, jerseys, T-

shirts, sweatshirts, sunglasses, umbrellas, toys and the like [International Class 28];

Advertising services, namely, providing advertising for newspapers, magazines, internet services, including web sites [International Class 35];

Entertainment services, namely theatrical productions, musical productions, audio and visual recordings, television and film productions, Internet, artwork, animation; and production services, namely documentaries, commercials, and radio in International Class 41.

Applicant's amendment did not include any fees for the additional classes set out in its proposed amendment.

In view of the proposed amendment, the application was remanded to the examining attorney on September 5, 2002.

The examining attorney and applicant exchanged communications and applicant, on December 26, 2002, proposed the following identification of goods and services:

Sunglasses, computer and multimedia software, namely, fixed media featuring theatrical performances, musical performances, television programs, motion picture films, audio and video recordings, animation, documentaries, commercials, and radio entertainment in International Class 9;

Stationery products, namely letterhead, envelopes, business cards, posters, stickers, bulletins and brochures featuring entertainment services namely, production of theatrical and musical performances, television programs, motion picture films, audio and video recordings, animation, documentaries, commercials, and radio entertainment in International Class 16;

Sports equipment and accessories, namely, baseballs, golf balls, golf tees, golf club covers, footballs, flying saucer toys, basketballs, jerseys, T-shirts, and sweatshirts in International Class 28;

Advertising services, namely, the preparation and dissemination of advertising matter via newspapers, magazines, and Internet web sites in International Class 35; and

Entertainment services, namely, theatrical and musical performances, television programs[,] motion picture films, audio and video recordings, animation, documentaries, radio entertainment, Internet web sites, commercials and museums in International Class 41.

The examining attorney pointed out several problems with the proposed identification of goods and services. When these issues could not be resolved, the examining attorney, on February 24, 2003, denied applicant's request for reconsideration. In the denial, the examining attorney again suggested additional changes to clarify the identification of goods and services. In addition, the examining attorney pointed out that applicant had only paid the fee for a single class and advised applicant that it must submit a fee for each international class for which it sought registration.

Applicant did not file a supplemental brief in response to the denial of its request for reconsideration and the examining attorney submitted her appeal brief.⁵

⁵ Applicant has not filed a reply brief.

The examining attorney raises several objections to applicant's proposed identification of goods and services. First, the examining attorney argues that "fixed media" is indefinite for Class 9 goods and the subject matter of the goods is not specified. Second, concerning the Class 16 goods, the examining attorney objects to the language "bulletins and brochures" as indefinite because the subject matter or field of the goods is not specified. In addition, she required clarification of the use of the goods. Third, the goods in Class 28 include "jerseys, T-shirts, and sweatshirts," which are actually classified in Class 25. Fourth, concerning the services in Class 41, the examining attorney argues that the "exact nature of the services is unclear." Brief at 7. The examining attorney has accepted the amendment to the services in Class 35.

Id.

We start by noting that applicant has identified goods and services in more than one class. A fee for each class is required. 15 U.S.C. § 1112 ("[I]f the Director by regulation permits the filing of an application for the registration of a mark for goods or services which fall within a plurality of classes, a fee equaling the sum of the fees for filing an application in each class shall be paid"). The Director has established such a system. 37

CFR § 2.86. Applicant has paid the fee for only one class.

See Denial of Request for Reconsideration, attachment.

Therefore, even if applicant's identification of goods and services is acceptable, it has not met this requirement and the examining attorney's refusal to register for applicant's failure to comply with this requirement is affirmed.⁶

Next, we look at the requirements for applicant to clarify its second amended identification of goods and services, which are the goods and services discussed by the examining attorney in her brief.⁷ We start with the goods

⁶ We note that applicant's original and first and second amended identifications of goods and services include goods and services in more than one class. These goods and services were classified in classes, inter alia, 9, 28, 35, and 41. Therefore, the examining attorney properly refused to accept these identifications of goods and services without the payment of the appropriate fee for each class even if the identifications of goods and services were acceptable.

⁷ The examining attorney considers the following identification of goods to be the identification of record because she advised applicant that "the applicant may not amend to include any goods or services that are not within the scope of goods or services set forth in the present identification." Denial of Request for Reconsideration at 3. We note that:

If the applicant proposes an amendment to the identification of goods and services, and the examining attorney determines that the amendment is unacceptable, the examining attorney should refer to the identification of goods before the proposed amendment to determine whether any later amendment is within the scope of the identification. In such a case, the applicant is not bound by the scope of the language in the proposed amendment but, rather, by the language of the identification before the proposed amendment.

in Class 9. Applicant's identification of these goods includes the words "fixed media," which the examining attorney has held to be indefinite. Applicant has not responded specifically to this requirement, or any of the proposed identification of goods or services requirements. We note that our own review of computer dictionaries does not indicate that "fixed media" is a term of art in the trade.⁸ The objectionable portion of the Class 9 goods is apparently "computer and multimedia software, namely, fixed media featuring theatrical performances, musical performances, television programs, motion picture films, audio and video recordings, animation, documentaries, commercials and radio entertainment." In addition, we

If the applicant submits an amendment to the identification of goods and services and the examining attorney determines that it is unacceptable, in whole or in part, the examining attorney should advise the applicant of the item or items that are unacceptable. The examining attorney should also advise the applicant that the previous items listed in the existing identification (not the unacceptable substitute) remain operative for purposes of future amendment. TMEP § 1402.07(d) (3rd ed. 2003).

Inasmuch as all the proposed identifications of goods and services are not acceptable, we will consider the second identification of goods, which is the least indefinite. However, we will also discuss the original identification of goods and services.

⁸ *Webster's New World Dictionary of Computer Terms* (2000) and *Microsoft Computer Dictionary* (5th Ed. 2002). We take judicial notice of the lack of definitions in these dictionaries. University of Notre Dame du Lac v. J.C. Gourmet Food Imports Co., 213 USPQ 594, 596 (TTAB 1982), aff'd, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983).

agree that applicant must indicate the field or subject matter of the television programs, motion picture films, audio and video recordings, animation, documentaries, and radio entertainment to make the identification of goods definite. These terms do not explain what is on the multimedia fixed media. These goods need to be further clarified to prevent an overly broad identification of goods that would make it difficult to determine likelihood of confusion issues.

Regarding the goods in Class 16, we agree that the identification of goods is indefinite. Bulletins and brochures are not goods in trade if they are simply advertising for applicant's goods and services.⁹ In re Douglas Aircraft Co., Inc., 123 USPQ 271, 271 (TTAB 1959) (This material [pamphlets, booklets, brochures, bulletins, and letterheads] serves only to advertise, explain, and publicize the goods in which applicant deals; and as such do not constitute 'goods' of applicant"). The examining attorney's requirement to clarify the nature of use of these goods is appropriate.

⁹ Indeed, the same would apply to letterhead, envelopes, business cards, posters, and stickers if they are used to advertise or promote applicant's other goods and services.

Regarding the goods in Class 28, "jerseys, T-shirts, and sweatshirts" are clearly in Class 25, and the examining attorney had properly required applicant either to delete those goods or add another class and fee. TMEP § 1401.02(a) (Class 25).

The services in Class 41 are "Entertainment services, namely, theatrical and musical performances, television programs, motion picture films, audio and video recordings, animation, documentaries, radio entertainment, Internet web sites, commercials and museums." The examining attorney correctly points out that television programs could include broadcasting television programs and producing television programs, which are classified in classes 38 and 41 respectively. Thus, this part of the identification of services is indefinite. Also, the term "Internet web sites" is indefinite because providing information via the Internet is classified by the service-related subject matter. Therefore, applicant's second proposed identification of goods and services is indefinite.

We also briefly address applicant's original identification of goods and services.

Entertainment services and production services of all types, towels, paper and toiletry products, chronometers, CD-ROMs, light fixtures of all types, sunglasses, sports equipment and accessories, animation, stationery products, jewelry of all types,

stuffed toys and toys, advertising services of all types, umbrellas, wall and floor coverings of all types, and the like in International Class 42.

As we discussed previously, this identification of goods is not acceptable for the simple fact that it contains goods and services in more than one class and applicant has only paid a fee for one class. Applicant argues that "'entertainment services' and 'production services' are understood as identifying a particular group of goods." Applicant's Brief at 2, citing, TMEP 804.03 (now TMEP 1403.02 (3rd ed. 2003)). However, applicant has not provided any evidence of use or even of how it intends to use the mark. Therefore, applicant has not provided any reason to deviate from the requirement that the "identification of goods or services must be specific, definite, clear, accurate and concise." TMEP 1402.01 (3rd ed. 2003); In re Port Huron Sulphite & Paper Co., 120 USPQ 343 (TTAB 1959) ("Paper other than board papers" approved because of evidence of actual use on various types of paper).

Inasmuch as the original identification of goods and services includes such indefinite items as "entertainment services and production services of all types, sports equipment and accessories, toys, and toiletry products," the examining attorney properly required applicant to

clarify the goods and services. See In re Air Products & Chemicals, Inc., 192 USPQ 84, 85 (TTAB 1976), recon. denied, 192 USPQ 157 (TTAB 1976) ("It is common knowledge that "catalysts" encompass a wide range of products and that there are catalysts which are used for a large variety of catalytic and chemical processes. Thus, the present identification could conceivably include a large number of catalysts which applicant does not manufacture. Under such circumstances, to allow applicant to register its mark for so broad an identification of goods would give it a scope of protection to which it is not entitled.").

We add that applicant's use of the phrase "and the like" also renders the original identification of goods and services indefinite.

The identification should state common names for goods or services, be as complete and specific as possible and avoid indefinite words and phrases. The terms ... "and the like" ... and other indefinite terms and phrases are almost always unacceptable.

TMEP § 1402.03(a).

Applicant has not shown any circumstances to demonstrate why this ordinarily indefinite term would be acceptable in its case.

Therefore, we affirm the examining attorney's requirement for a clarification of the original identification of goods and services. For the sake of

completeness, we have discussed applicant's second proposed amended identification of goods and services, and we agree that this identification is also indefinite. We also affirm the requirement that applicant is not entitled to registration of its mark even if the identification of goods and services is definite because applicant has not paid the required fees for the additional classes.¹⁰

Decision: The refusal to register is affirmed.

¹⁰ As we have now decided this appeal, we advise applicant of the provision of 37 CFR § 2.142(g): "An application which has been considered and decided on appeal will not be reopened except for the entry of a disclaimer under § 6 of the Act of 1946 or upon order of the Director, but a petition to the Director to reopen an application will be considered only upon a showing of sufficient cause for consideration of any matter not already adjudicated." See also 37 CFR § 2.144; *Trademark Trial and Appeal Board Manual of Procedure* § 1218 (2d ed. 2003).